

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-17 were pending in this application when last examined and stand rejected.

Claims 1-17 are amended in a non-narrowing manner to make minor editorial revisions to better conform to U.S. claim form and practice. Such revisions are non-substantive and not intended to narrow the scope of protection. Such revisions include: replacing the "characterized by" language with "wherein"; revising the beginning of the claims to recite "A" or "The"; and revising the claim language to provide proper antecedent basis throughout the claims. Further support for amended claim 1 can be found in the disclosure, for example, at page 4, lines 4-15, and at page 6, lines 4-30. Further support for amended claim 4 can be found in the disclosure, for example, at page 4, lines 10-15. Further support for amended claim 10 can be found in the disclosure, for example, at page 7, lines 22-30. Further support for amended claim 15 can be found at page 7, lines 16-19. Support for amended claim 16 can be found in Fig. 2.

No new matter has been added by the above claim amendments.

New dependent claims 18 and 19 have been added. Support can be found in claims 3 and 9 and the disclosure, for example, at page 3, lines 1-5. No new matter has been added.

Claims 1-19 are pending upon entry of this amendment.

The specification is amended to include appropriate section headings to conform to U.S. practice. No new matter has been added.

Applicants are submitting the present Amendment without prejudice to the subsequent prosecution of claims to some or all of the subject matter which might be disclaimed by virtue of this response (although none is believed to be), and explicitly reserves the right to pursue some or all of such subject matter, in Divisional or Continuation Applications.

Applicants thank the Examiner for the careful examination of this case and respectfully request reexamination and reconsideration of the case, as amended. Below Applicants address the rejections in the Office Action and explain why the rejections are not applicable to the pending claims as amended.

II. INDEFINITENESS REJECTION

Claims 3, 9, and 15-17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons in items 2-8 on page 2 of the Office Action.

This rejection is respectfully traversed.

In items 3-4 of the Office Action, the Examiner argues that it is unclear what is meant by "the removal from the holder takes place while retaining orientation." Applicants respectfully disagree and submit that such language is clear and definite based on the description of such in the disclosure. In this regard, it is well established that definiteness of claim language is analyzed, not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). See also M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2173.02.

In this case, the specification discloses, at page 3, lines 1-5 of the disclosure:

the removal from the holder can take place while retaining orientation. Thus, it can be effected, for instance, that the cut-off cutting is introduced into a growing medium in the right orientation, that is to say with the sprout points in a direction remote from the growing medium.

Based on such disclosure, it would be clear to the skilled artisan that the orientation means that the sprout of the cut-off lump piece points in a direction remote from the growing medium. Based on such, Applicants believe that the claim language is clear and definite to the skilled artisan. Nonetheless, Applicants have added new dependent claims 18 and 19 to further specify this orientation.

Claims 15-17 have been amended to better define the subject matter more clearly and distinctively in a non-narrowing manner and to eliminate the noted insufficient antecedence issues.

The claims are thus clear, definite and have full antecedent basis.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

III. PRIOR ART REJECTIONS

Claims 1, 2, and 6-8 were rejected under 35 U.S.C. § 102(b) as anticipated by MEESTER (U.S. 2,167,337) for the reasons in items 10-15 on page 3 of the Office Action.

Claims 1, 3, 6, 7, and 9 were rejected under 35 U.S.C. § 102(b) as anticipated by GROVES (U.S. 5,899,019) for the reasons in items 16-21 on pages 3-4 of the Office Action.

Claims 1 and 6 were rejected under 35 U.S.C. § 102(b) as anticipated by AKERSON (U.S. 4,361,959) for the reasons in items 22-24 on page 4 of the Office Action.

Claims 1, 5, 6, 12, and 17 were rejected under 35 U.S.C. § 102(e) as anticipated by ROMBOUTS (US2004/0118041) for the reasons in items 25-30 on pages 4-6 of the Office Action.

Claims 4, 10, and 11 were rejected under 35 U.S.C. § 103(a) as obvious over AKERSON (U.S. 4,361,959) for the reasons in items 32-35 on pages 5-6 of the Office Action.

Claims 13-15 were rejected under 35 U.S.C. § 103(a) as obvious over ROMBOUTS (US2004/0118041) for the reasons in items 36-38 on page 6 of the Office Action.

Claim 16 was rejected under 35 U.S.C. § 103(a) as obvious over MEESTER (U.S. 2,167,337) for the reasons in items 39-40 on pages 6-7 of the Office Action.

These rejections are respectfully traversed and will be discussed together below.

It is well established that to anticipate a claim, a cited prior art reference must disclose or suggest each and every element of the claimed invention. See, M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2131.

It is also well established that to support a *prima facie* case of obviousness, the Office must provide a rationale showing that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions to yield predictable results. See, *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 U.S.P.Q.2d 1385, 1395 (2007); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.02.

Applicants respectfully submit that the prior art rejections fail, because the cited references fail to disclose or suggest the feature of "closing the longitudinal opening, so that the introduced cut-off lump piece is enclosed in the holder" in

amended claim 1 and the feature of "closing the longitudinal opening, so that an introduced part of the cut-off lump piece is enclosed in the holder" of amended claim 6. It is noted that claims 1 and 6 are the independent claims.

Applicants will first discuss the rejections as applied to the method of independent claim 1.

Meester (US'337) and Groves (US'019) both relate to the stripping of thorns and excess foliage from stem plants. However, this process significantly differs from separating a lump piece of rosette plants as in the method of independent claim 1.

In the method of the present application, the cutting of rosette plants during the multiplication process is more difficult than the cutting of stem plants. The cutting of rosette plants nearly always takes place in sterile conditions (page 1, line 23). Further, it is important not to damage the growing points or to damage them as little as possible during the cutting process (page 1, line 23). This requires delicate handling during the cutting process.

To enable this delicate handling, the method of claim 1 prescribes that after cutting, the cut-off lump piece is enclosed in the holder. Specifically, the method of independent claim 1 requires "closing the longitudinal opening, so that the introduced cut-off lump piece is enclosed in the holder." Similarly, independent claim 6 requires "while closing the longitudinal opening, so that an introduced part of the cut-off

lump piece is enclosed in the holder." Meester and Groves fail to disclose or suggest these features of claims 1 and 6.

As can be seen from FIG. 1 of Meester and FIG. 2 of Groves, both the thorn removing device and the stripping tool are open and do not protect the stem plant by enclosing the cut-off part. This is not surprising, since the stripping of thorns and excess foliage from stem plants does not require such protection.

For these reasons, it is clear that Meester and Groves fail to anticipate or render obvious claim 1, because Meester and Groves fail to disclose or suggest the above-noted features of the claim.

As to Akerson (US'959), the patent relates to a brush cutter. However, a cutting brush obviously differs from the cutting of rosette plants. As discussed above with respect to Meester and Groves, the multiplication of rosette plants requires delicate handling. However, the goal of cutting brush stands in contrast to the delicate handling required for cutting rosette plants. In brush cutting, the cut-off part of the brush dies after cutting. It might even be dead before cutting. Also, see FIG. 5 of Akerson, wherein it is clear that the cut-off part of the brush will fall out of the holder. In other words, in the method in Akerson, the cut-off part of the brush is not enclosed in the holder as prescribed by claim 1. Indeed, there is no need in Akerson to keep the cut-off brush enclosed in the holder.

For these reasons, it is clear that Akerson fails to anticipate independent claim 1, because the reference does not disclose or suggest the above-noted features of the claim.

Rombouts (US'041) concerns the mechanical separation of cuttings from a plant branch. A plant branch is much more robust than a rosette plant and does not need the same care as needed when cutting a rosette plant.

Rombouts cutting mechanism holds the cut-off branch securely clamped between two pressure exerting pieces [0043]. However, the cut-off part is not enclosed in a holder, as prescribed by claim 1 of the present application. Again, there is no need to do so in the method of Rombouts.

For these reasons, it is clear that Rombouts fails to anticipate claim 1, because the reference does not disclose or suggest the above-noted features of the claims.

Indeed, it could be said that Meester, Groves, Akerson, and Rombouts actually teach away from the method of claim 1. As discussed above, the cited references simply do not require the delicate handling in which the cut-off lump piece is enclosed in the holder as in claim 1. The cited references simply do not require delicate handling, and in fact disclose the opposite, wherein the cut-off plant pieces are permitted to die and/or are not saved at all.

In this regard, it is well established that a prior art reference must be considered in its entirety, i.e., as a whole,

including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2141.02, VI. It is well established that a prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2145, X, D, 1.

For these reasons, it is believed that the cited references actually teach away from the method of claim 1.

Thus, Applicants believe that claim 1 and all claims dependent are novel and patentable over the above-discussed prior art references. Therefore, the above-noted anticipation and obviousness rejections over independent claim 1 are believed to be overcome, and thus should be withdrawn.

Applicants will now discuss the rejections as applied to the apparatus of independent claim 6.

Similar to claim 1, independent claim 6 requires "while closing the longitudinal opening, so that an introduced part of the cut-off lump piece is enclosed in the holder."

In terms of claim 6, Meester discloses (terms between brackets from Meester) an elongated holder (the thorn removing device itself) which comprises a longitudinal opening (the opening between arms 1 and 2) at least along the longitudinal axis (axis parallel to the arms 1 and 2). Further, claim 6

prescribes a first cutting element for cutting off a lump piece along a cutting plane parallel to the longitudinal axis, while closing the longitudinal opening, such that an introduced part of the lump piece is enclosed in the holder.

When one considers the knives 6 and 7 to be the first cutting element in Meester, it is clear that there are two candidates for "the lump piece" that is to be cut-off. First, the thorns and foliage may be considered the lump piece to be cut off. In that case, the cut-off thorns and foliage will fall on the ground and they are not enclosed in the holder, as prescribed by claim 6.

Second, the stem may be considered the lump piece to be cut off. In that case, the knives 6 and 7 do not cut the stem, and consequently, the lump piece is not cut while closing the longitudinal opening, as prescribed by claim 6.

It is noted that the thorn removing device in Meester comprises two more knives 31 and 32 so that the device can also be used as a shear for cutting stems (page 1, column 2, lines 40-42). When one considers these knives as the first cutting element, the only candidate for "the lump piece" that is to be cut-off is the stem. In that case, the part that is cut-off from the stem will fall on the ground and is not enclosed in the holder, as prescribed by claim 6.

Therefore, independent claim 6 is clearly novel and patentable over Meester.

With respect to claim 6, Groves discloses (terms between brackets from Groves) an elongated bolder (the stripping tool itself) which comprises a longitudinal opening (the opening between handles 28a and 28b) at least along the longitudinal axis (axis parallel to handles 28a and 28b). Further, claim 6 prescribes a first cutting element for cutting off a lump piece along a cutting plane parallel, to the longitudinal axis, while closing the longitudinal opening, such that an introduced part of the lump piece is enclosed in the holder.

When one considers the side stripping blades 40a and 40b in Groves as the first cutting element, there are two candidates for "the lump piece" that is to be cut-off.

First, the thorns and foliage may be considered the lump piece to be cutoff. In that case, the cut-off thorns and foliage will fall on the ground (see FIGS. 9 and 10) and they are not enclosed in the holder, as prescribed by claim 6. Second, the stem may be considered the lump piece to be cut off. In that case, the side stripping blades 40a and 40b do not cut the stem, therefore, the lump piece is not cut, as prescribed by claim 6.

Therefore the present application is novel and patentable over Groves.

From FIG. 5 of Akerson (US'959), it is clear that the cut-off part of the brush will fall out of the holder and is not enclosed in the holder, as prescribed by claim 6, Therefore the present application is novel and patentable over Akerson.

In Rombouts, when the cutting mechanism holds the cut-off branch clamped between two pressure exerting pieces [0043], it is not enclosed in a holder, as required in claim 6.

Therefore the present application is novel and patentable over Rombouts.

Again, enclosing the separated part of the lump piece in the holder enables delicate processing during the multiplication of rosette plants (see above).

The cited references do not mention a holder that encloses the cut-off part of the plants. Nor do the references suggest a solution for enabling the delicate handling. Again, this is no surprise, since all of the references simply do not require delicate handling. Indeed, as discussed above, the cited prior art references teach away from this concept. This teaching away is indicative of the non-obviousness of the claims.

For these reasons, claim 6 novel and patentable over Meestor, Grooves, Akerson, and Rombouts.

In light of the above, Applicants respectfully submit that both the method claim 1 and the apparatus claim 6 are patentable over the cited documents.

Since Applicants have addressed the independent claims, there is no need to further discuss the dependent claims.

For these reasons, Applicants ask that the anticipation and obviousness rejections be withdrawn.

V. CONCLUSION


In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON


Jay F. Williams, Reg. No. 48,036
209 Madison Street, Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

JFW/